REMARKS

Upon entry of the above amendments, claims 17- 36 will be pending. Applicants are also filing herewith an Information Disclosure Statement.

In view of the above amendments, and the following remarks, Applicants respectfully request reconsideration and allowance of the present Application.

In the Office Action dated May 19, 2005, claim 16 is rejected under 35 USC Section 103 as being unpatentable over the Havens patent (US Patent No. 5,909,669) in view of Carter et al. (U.S. Patent No. 5,428,738), and further in view of an article entitled "Databases with Character" by Darlings et al. In addition, claim 16 has been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 a copending U.S. Patent Application No. 09/672,830.

Initially, Applicants will respond to the obviousness-type double patenting rejection. Applicants respectfully request the Examiner to address each claim limitation and provide evidence that establishes the obviousness of the claims of the present Application in relation to the claims of the copending Patent Application 09/672,830, so as to provide a *prima facie* case of obviousness. The claims of the present Application are similar to claims of the noted co-pending Application in certain respects. However, the noted copending Application claims recites, among other features not recited in any of the claims of the present Application, an employee set-up mechanism to create a database record for an employee.

Applicants further traverse the rejection of claim 16 as being obvious over Havens in view of Carter and Darlings et al. Applicants note that claim 16 has been replaced with new claims 17-36. Independent claims 17 and 35 recite, among other features, receiving data units from a given source and to storing these data units. The received data units as stored are associated with plural data unit types. The inventions of claims 17 and 35 each receive data units and configure a custom performance metric based on selected ones of the received data units. The name of the custom performance metric can be coined by the user by inputting a flexible textual character term. Data unit types are selected for use to formulate the custom performance metric. At least one mathematical operation is defined to be performed on received and stored data units associated with the selected data unit types.

The undersigned hereby requests a personal interview with Examiners Kalinowski and Bui, to seek a better understanding of the positions taken both in the July 28, 2004 Office Action and in the May 19, 2005 Office Action. Among other questions, the undersigned does not completely understand the manner in which the Examiner is considering modifying the primary reference in view of the teachings of the secondary references.

It is understood that the Examiner will give claim language its broadest reasonable interpretation, and that the motivation to combine references need not be explicit, nor need it be the same as Applicants' own reasons for providing a given feature. However, it is respectfully requested that the Examiner further elaborate on any assumptions made in the rejections, on the interpretations of the claim language to support those rejections, and finally on the precise make-up of the system of the primary reference as modified in the Office Action (in this instance, the modified Havens productivity assessment system). The undersigned cannot fully appreciate what the modified system looks like.

For example, the May 19, 2005 Office Action states, on page 3 (in explaining the combination of Havens with Carter et al., along with the motivation for such combination), that "[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to include data configuration user interface with input mechanism having text, and mathematical operator input mechanism disclosed by Carter et al. with the motivation of facilitating user input by replacing complex logical constructs by easily recognized visual equivalents on computer screen. Carter et al. col. 1, lines 34-38."

Applicants submit that providing the Havens system with an input mechanism having text would require that a decision be made as to which type of text would be received by the input mechanism in such a modified Havens system, and how that text would relate to the data types and data units referred to throughout the Havens patent.

Applicants note that Havens defines (at least) the following data types (referring, for example, to Fig. 1 of Havens);

- Information criteria values, including, for example, Applicability rank 50, criterion weight 54, and an absolute weight 58.
- Worker criteria values, including, for example, Information Usage rank 52, criterion weight 56 and an absolute weight 59.

- Information criteria sector values, including rank, criteria weight, and absolute weight totals 51, and including an information sector weight 55.
- Worker criteria sector values, including rank, criteria weight, and absolute weight totals 53, and including a worker sector weight 57.

Is there a specific term one of ordinary skill in the art would decide to provide for textual input for, that corresponds with a particular data type in the Havens system? Is there an example that can be described for the type of input mechanism that would be provided in the Havens system?

Applicants submit that claims 24 and 42 recite and require more than the provision of an input mechanism having text in a performance management system. The modification of Havens is described in the Office Action as ("...to include data configuration user interface with input mechanism having text..."). Specifically, the claim recites, among other things, a metric name input presenter that presents, on a computer screen, a metric name input field to receive from user input a flexible textual character term coining a name for a custom performance metric. Claim 24 further recites that the presenter is preconfigured to present the recited input.

Applicants notes that the Examiner has interpreted the term "performance metric" to include the object functions referred to in the Carter et al. patent. While Applicants may disagree with this interpretation of the term "performance metric" as recited in, for example, claim 17, Applicants must note that the Examiner is still presented with the dilemma of explaining the applicability of the teachings of Carter et al. to the specific system of Havens. In other words, if a motivation exits to modify the Havens system, in which way does the prior art suggest modifying the Havens system?

Applicants submit that in order to modify the Havens system, a decision would have to be made by one of ordinary skill in the art as to which mathematical operation functions of the Havens system would be definable with a new mathematical operator input mechanism. Applicants ask the Examiner to explain how the Havens system could be modified to "replace complex logical constructs by easily recognized visual equivalent on a computer screen."

Havens performs (at least) the following mathematical operations:

- Totals 51 and 53 are calculated for each sector.
- Various calculations are performed by calculator 38 (See, e.g., Havens Spec. Col. 8, Lines 50-58), including high, low, mean, median, and standard deviation for sector

totals 51 and 53, for sector weights 55 and 57, and other values suitable for comparison with one or more benchmark values contained in benchmark database 18.

- Validator 22 examines survey data 15 (in accordance with one or more validation parameters) to determine whether survey data is suitable for generating one or more knowledge worker productivity assessments (Havens Spec. Col. 7, Lines 6 *et seq.*).
- Segmenter 26 examines survey data, including rank values, and it determines whether to segment survey data into multiple survey data segments (Havens Spec. Col. 7, Lines 22 *et seq.*).
- Uniformity calculations are also performed as a part of the segmentation process (Havens Spec. Col. 7, Lines 36-49).
- Relator 40 also performs calculations comparing comparison values to one or more bench mark values contained in and selected from bench mark databases 18 (Havens Spec. Col. 9, Lines 9 *et seq.*).

Applicants respectfully request the Examiner to elaborate as to how any of the teachings of the Carter et al. patent would help simplify the mathematical operations performed by the Havens patent, where those mathematical operations are already programmed in the system. In fact, the Havens patent does not require that a user without programming skill be allowed or required to define the mathematical operations. The purpose of the system of the Havens patent is to provide for specific calculations as described.

Nonetheless, should a mathematical operator input mechanism be provided in the Havens systems, Applicants submit that it would not be an easy task to even propose an example of how such a modification would be made.

Applicants note that independent claims 17 and 35 recite, among other limitations, an operator input presenter presenting, on a computer screen, an operator input field to receive from user input at least one defined mathematical operation to be performed on data units associated with the selected type terms.

The operator input presenter accordingly defines one or more mathematical operations to be performed on data units of selected type for the formulation of a custom performance metric, the name of which has been coined by the metric name input.

Does the modification of Havens in view of Carter et al. contemplate all these limitations as well? Again, elaboration of these details and how they would be incorporated is requested.

The above questions are examples of types of questions that come to mind, as we consider the actual manner in which the references may be combined to reject the claims.

Applicants note that the Havens patent includes a number of mathematical operations that are performed on various types of data. Those mathematical operations are hardwired into the system. The system does not require, nor is there any statement or implication anywhere in the Havens patent, that it would be beneficial for a user to be able to add or modify mathematical operations in the Havens system. Accordingly, Applicants submit that, absent the impermissible use of hindsight using Applicants' own disclosure, one of ordinary skill in the art would not consider modifying the Havens system to include a metric name input (i.e., as recited in the claims – not just any generic text input field) for the purpose of coining a name for a custom performance metric to be defined, a feature recited in independent claims 17 and 35.

Specifically, the Havens system, considered alone or in any proper combination with any other reference of record (including Carter et al. and the Darlings et al. article), is lacking a metric name input to receive a flexible textual character term coining a name for a custom performance metric to be defined, whereby select ones of plural data unit types are associated with the coined named for the custom performance metric.

None of the references of record, considered alone or in any proper combination, teaches this feature. The only one of the references applied in the outstanding Office Action that pertains to performance metrics (i.e., Havens) teaches a specific set (unchangeable) of data unit types corresponding to information and worker values. The Havens system does not include a mechanism for selecting ones of plural data unit types associated with data units received by the system, where the data units associated with the selected data unit types are associated with a mathematical operation and also with a custom performance metric, the name of which has been coined by the use of the metric name input.

The Carter et al. patent simply does not provide any teaching which would remedy these deficiencies of the Havens patent. The Darlings et al. article entitled "Databases with Character" further provides no teaching or suggestion which would remedy these deficiencies in the Havens patent.

The Carter et al. patent discloses a logical expression calculation interface. The Carter et al. patent relates to the WordPerfect InForms product which is a software product that provides the capability of designing and maintaining elaborate electronic and printed forms. The Darlings

et al. article discloses certain databases which have flexible and beneficial features, including Clarion which has a data dictionary. The article mentions that, for a given field, one may assign a display format and an initial value as well as a column heading and a prompt.

Applicants note that, in various respects, each of these references teaches, among other features, the use of graphical displays for displaying variables, for displaying mathematical operators, and for allowing users to input variables and mathematical operators. In a vague sense, Applicants can appreciate that a database such as the Clarion database as disclosed by the Darlings et al. article may disclose the use of a graphical interface for helping associate one type of data with another type of data. However, these general (out of context) teachings do not address the specific limitations recited in the independent claims, as noted above.

Moreover, and perhaps more importantly, the combination as described in the Office Action does not enumerate all the limitations in claim 17 (or even previously pending claim 16), and it cannot unless some sort of step-by-step explanation is provided to address each feature modification made to the Havens system.

As we noted in the Response that was filed on January 28, 2005, the ease with which a human resources management system can be configured and the usefulness of the information ultimately presented to the user both depend in large part on flexibility. For information technology (IT) systems, issues like these are "holy grail" issues.

The simplicity and clarity of the different types of data received by the recited metric name input presenter, data unit type input presenter, and operator input presenter, is no way suggested by nor in any way similar to the complexity that is evident by simply reviewing the references applied in the Office Action. The Havens patent is an inflexible system which does not allow for the coining of a new performance metric, and does not allow for the selection of data unit types from among received data unit types, nor for the definition of at least one mathematical operation to be performed on data units associated with the selected types. Havens further fails to disclose a data association mechanism as recited in the new independent claims.

Applicants submit that properly modifying the Havens system in view of the teachings of any one or more references of record (including Carter et al. and the Darlings et al. article) cannot produce a modified system as claimed. The combination proposed in the outstanding Office Action raises more questions than it answers, and thus, Applicants respectfully submit, must be relying on Applicants' own disclosure in hindsight. The simplicity, clarity, and criticality of, for

example, the recited invention of claim 17 weighs heavily against any arbitrary combination of features (well known or not) to reject the claims.

For at least these reasons enumerated above, Applicants submit that claims 17-36 are each patentable under Sections 102 and 103 over the references of record, considered in any proper combination.

In view of the foregoing, reconsideration and allowance are respectfully requested. A Notice to that effect is earnestly solicited.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

Dated: 11/21/05

By: _____

Anthony L. Miele, Attorney for Applicants
Registration Number 34,393
Miele Law Group
2 Summer Street, Suite 306
Natick, MA 01760
Phone: 508-315-3677 Fax: 508-319-3001